

REMARKS

Claims 1-79 were presented for examination. In final Office Action dated July 24, 2008, claims 1-79 were rejected.

Applicants thank the Examiner for examination of the claims pending in this application and address the Examiner's comments below. Based on following Remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and withdraw them.

Response to Rejection Under 35 U.S.C. § 103(a) in View of Davies and Klotz

In the 3rd paragraph of the Final Office Action ("FOA" herein), Examiner rejects claims 1-6, 19-20, 27-32, 35-49, 54-55, 59-68, and 73-74 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Publication No. 2002/0085759 ("Davies") in view of U.S. Patent No. 5,682,540 ("Klotz"). This rejection now is traversed.

Independent claim 1 recites:

A computer-implemented method for processing a stored document, comprising:

- receiving an image of a document index, the document index comprising a plurality of graphic representations of documents, wherein each graphic representation uniquely identifies a document;
- locating, within the plurality of graphic representations of documents on the document index image**, at least a first graphic representation of a first stored document;
- locating, on the document index image **with respect to the location of the first graphic representation of the first stored document**, an image of a first sticker specifying a first action;
- determining that the first sticker specifies the first action be performed on the first stored document **based on the location** of the first sticker **with respect to** the location

of the first graphic representation of the first stored document; and
performing the first action to cause a change to the first stored document.

These aspects of the claimed invention pertain to the manipulation of stored documents using the relative locations of stickers specifying actions to the locations of graphic representations of the stored documents on a document index. These aspects of the claimed invention are not disclosed or suggested by the cited references considered alone or in the combination proposed by the Examiner.

Specifically, Klotz does not teach or suggest “locating, **within the plurality of graphic representations of documents on the document index image**, at least a **first graphic representation** of a first stored document.” Klotz teaches a document surrogate showing summaries of multiple documents. *See* Klotz, col. 13, ll. 52-56. The Examiner correlates Klotz’s second windows 86 (“nine window summary”) with the “graphic representations” of the claimed invention. *See* FOA, p. 3 (bottom). Applicants note that proper antecedent basis requires that the “at least a first graphic representation” that is “locat[ed] within the plurality of graphic representations” thus also be Klotz’s second windows 86. However, the Examiner relies instead upon Klotz’s selections boxes 82 for the locating step. *See* FOA, p. 4, (relying on Klotz col. 13, ll. 63-67 and col. 14, ll. 31-34). Thus Klotz does not meet this element.

In addition, Klotz indicates that the system “will then *know to scan the image where selection boxes 82 are located*” to “*detect* presence or absence of user supplied selections.” Klotz, col. 14, ll. 31-37 (emphasis added). The fact that the locations of the selection boxes **are known** indicates that Klotz doesn’t need to do **any** “locating,” but rather merely

“detects” marks (or lack thereof) at **known** locations. Thus, Klotz also is deficient for this additional reason.

Davies does not remedy the deficiencies of Klotz. As a preliminary matter, Davies does not remedy the above-stated deficiencies of Klotz, nor does the Examiner allege that it does. Rather, the Examiner relies on Davies for other elements of the claimed invention, shown below also to be deficient. Specifically, Davies does not teach or suggest “locating, on the document index image **with respect to the location of the first graphic representation of the first stored document**, an image of a first sticker specifying a first action.”

Davies teaches a sticker for placement on a document; which includes a glyph field 112 with a service code 212 encoding an action. *See* Davies, [0034] – [0038]. Applying the sticker to a document and scanning the document triggers the action to be performed on the document. *See* Davies, [0015]. The Examiner points to language in Davies indicating Davies’ teaching the ability to locate the sticker on the scanned document. *See, e.g.,* Davies, [0051]. However, Davies’ sticker location is **not** found “within the plurality of graphic representations of documents” as claimed. In addition, in contrast to the claimed invention, in which the action is correlated with a particular document “**based on** the location of the first sticker with respect to the location of the first graphic representation,” the **location** of the sticker in Davies has **nothing to do with** the action to be performed.

The Examiner also points to the mention of possible use of a cover sheet in Davies [0035]. *See* FOA, p. 2 and 26. The Examiner’s reliance on this paragraph of Davies is misplaced. Paragraph [0035] indicates merely that Davies’ stickers *can be applied to various objects* that can be “associated with documents,” listing “cover sheets” as one example of

such objects. The text of Davies does not say how cover sheets specifically might be associated with documents. Davies provides only one example of how other objects (such as cover sheets) might become associated with documents, in which a lapel pin is (manually) associated with a document by “scanning the lapel pin...at the same time the document is scanned.” Davies, [0035]. Nowhere does Davies teach or even suggest applying a sticker to a cover sheet “comprising a plurality of graphic representations of documents.” Indeed, Davies *warns against* the use of cover sheets as “a form for specifying commands” because they are “tedious and relatively inefficient,” and “inconvenient to maintain a supply” of. Thus, the Examiner’s statements in the Response to Arguments section on p. 26 of the FOA with respect to the obviousness of applying stickers to cover sheets based on [0035] of Davies are unfounded and require untenable leaps in logic over those teachings. Applicants note that the Examiner does not allege that Klotz shows these aspects of the claimed invention.

The combination of Klotz and Davies also does not remedy the above-stated deficiencies. And for the reasons above, the Examiner’s statement that Davies is a “method of processing coversheets” is incorrect. Because of the above-discussed deficiencies of Klotz and Davies, the Examiner has failed to establish even a *prima facie* basis from which a proper determination of obviousness under 35 U.S.C. § 103(a) can be made. Thus, Applicant submits that claim 1 is patentably distinguishable over Klotz and Davies, alone or in the suggested combination.

Independent claims 42, 49, and 63 also are patentably distinguishable over Klotz and Davies for the reasons stated above.

Claims 2-41, 43-48, 50-62, and 64-79 respectively depend from claims 1, 42, 44, and 63 and thus are distinguishable over Klotz and Davies by reason of their dependence. In addition, claims 2-41, 43-48, 50-62, and 64-79 recite additional patentably distinguishable features not disclosed by Klotz and Davies. Thus, Applicant submit that claims 2-41, 43-48, 50-62, and 64-79 also are patentably distinguishable over Klotz and Davies, alone or in the suggested combination.

Response to Rejection Under 35 U.S.C. §103(a)
in View of Davies, Klotz, Cooper, and Cotte

In the 4th paragraph of the final Office Action, Examiner rejects claims 7-18, 21-26, 33-34, 50-53, 56-58, 69-72, and 75-79 under 35 USC § 103(a) as allegedly being unpatentable over Davies and Klotz and in further view of U.S. Patent No. 5,680,223 (“Cooper”) and U.S. Patent No. 5,499,108 (“Cotte”). This rejection now is traversed.

Claims 7-18, 21-26, 33-34, 50-53, 56-58, 69-72, and 75-79 are patentably distinguishable over Klotz and Davies for the reasons discussed above.

Cooper and Cotte do not remedy the above-stated deficiencies of Klotz and Davies, nor does the Examiner allege that they do. Rather, the Examiner relies on Cooper and Cotte for specific recitations with the dependent claims.

Applicants note that Cooper and Cotte suffer from similar deficiencies as Klotz and Davies, respectively, as discussed above. Specifically, Cooper is similar to Klotz in that the locations of check boxes are known (not graphic representations of documents and do not require “locating”). *See, e.g.*, Cooper, col. 10, ll. 43-45. Cotte is similar to Davies in that its stickers act on the document on which it was placed (not a document index or relative location within the same). *See, e.g.*, Cotte, col. 13, ll. 17-22.

Thus, claims 7-18, 21-26, 33-34, 50-53, 56-58, 69-72, and 75-79 also are patentably distinguishable over Cooper and Cotte, alone or in the suggested combinations with Klotz and Davies.

Conclusion

In sum, Applicants respectfully submit that all claims 1-79 are patentably distinguishable over the cited references for at least the reasons given above, while not necessarily conceding any contention not specifically addressed. Applicants request reconsideration of the basis for the rejections of these claims and request allowance of them.

If the Examiner believes that for any reason direct contact with Applicants' attorney would help advance the prosecution of this case, the Examiner is invited to telephone the undersigned at the number given below.

Respectfully Submitted,

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